



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,284	04/23/2007	Hans de Vries	STERN21.007APC	1847
20995 7590 10/08/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER SAVAGE, JASON L				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
10/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/576,284

Applicant(s)

VRIES ET AL.

Examiner

JASON L. SAVAGE

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/88)
Paper No(s)/Mail Date 20060417
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/578,796. Although the conflicting claims are not identical, they are not patentably distinct from each other because Application'796 recites a method of forming a coated workpiece comprising a substrate and electrodeposite one or more (emphasis added) layers containing at least one metal and/or metal alloy (claim 1). Application'796 further recites that as a coated metal alloy, aluminum/magnesium may be formed (claim 8).

Although Application'796 does not explicitly recite that an intermediate layer is provided, it teaches that one or more layers of a metal alloy are formed on the substrate which would meet the claim limitations.

Application'796 further recites that the substrate is electrically conductive (claim 3), it may be a metallic substrate or may be metallized (claim 4), the same substrate materials are used (claim 5), the same materials which may form an intermediate coating are used (claim 7), and the coating may be applied to the same workpiece components as claimed (claim 16).

Application'796 does not recite the aluminum/magnesium or intermediate layer thickness or the magnesium content in the aluminum/magnesium alloy such as recited in claims 6-8 of the instant Application, however the recited claim limitations would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 9-11, 13-14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer et al (WO 02/088434).

Fischer teaches a coated workpiece wherein an aluminum/magnesium alloy is formed by electroplating (abs). Fischer further teaches that a base metal substrate may be coated with the aluminum/magnesium coating (p. 2, ln. 25-33). Fischer further

teaches that the base metal substrate may have an intermediate layer of nickel formed prior to the deposition of the aluminum/magnesium alloy (p. 3, ln. 22-24). As such, Fischer teaches a coated workpiece comprising a base metal substrate, an intermediate nickel metallic layer and aluminum/magnesium alloy surface coating.

Regarding claims 2-3, the base metal substrate would be considered to be electrically conductive and made of metal.

Regarding claim 5, the intermediate layer comprises nickel.

Regarding claim 9, the coated workpiece of Fischer would be considered a bulk material.

Regarding claim 10, Fischer would meet the claim limitations wherein the intermediate metal layer is coated on the substrate and wherein the aluminum/magnesium alloy is coated on the intermediate metal layer.

Regarding claim 11, although Fischer does not explicitly recite the nickel plating method employed, the plating would either need to be formed from an aqueous or non-aqueous solution and thus would meet the claim limitation.

Regarding claims 13-14, Fischer teaches that an anhydrous electrolyte is used to electrodeposit the aluminum/magnesium layer (abs).

Regarding claim 18, although Fischer does not explicitly recite that the coated component is selected from the claimed items, it is the position of the Examiner that the coated component would meet the limitation of being a metal sheet.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6-8, 12, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer et al (WO 02/088434)..

Fischer teaches what is set forth above but is silent to some of the claim limitations.

Regarding claims 4 and 17, although Fischer does not recite a specific material for use as the substrate, it teaches that any base metal may be used (p. 2, ln. 25-33). As such, it would have been obvious to one of ordinary skill to have utilized any of a wide number of substrate materials including the metal materials such as iron and steel with a reasonable expectation of success.

Regarding claims 6 and 8, Fischer is silent to the thicknesses of the intermediate and aluminum/magnesium layers. However, it would have been within the purview of one of ordinary skill to have selected thicknesses for the recited layers that would make the article suitable for its intended use. Absent a teaching of the criticality or showing of unexpected results from the claimed layers having the claimed thicknesses, it would not provide a patentable distinction over the prior art.

Regarding claim 7, Fischer does not specify the desired magnesium content in the aluminum/magnesium alloy. However the selection of an alloy with a magnesium

content which may range from 0.5 to 70% by weight would have been obvious to one of ordinary skill in the art.

Regarding claim 12, Fischer is silent as to the method of forming the intermediate nickel layer. However, it would have been within the purview of one of ordinary skill in the art to have formed the nickel plating by any known method including using a aqueous electrolyte to electrodeposit the intermediate layer.

Regarding claims 15-16, Fischer is silent to applying an electrically conductive layer prior to forming the intermediate layer such as by a metallization method. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that additional layers could be provided in the composite of Fischer with a reasonable expectation of success. Absent a teaching of the criticality or showing of unexpected results from recited claim limitations, it would not provide a patentable distinction over the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON L. SAVAGE whose telephone number is (571)272-1542. The examiner can normally be reached on M-F 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Savage/
10-01-08

/Timothy M. Speer/
Primary Examiner
Art Unit 1794